

Atty. Docket No. CPAC 1029-8
Appl. No. 10/681,734

PATENT

Remarks

Claims 1 - 8 and 15 - 20 are in the application. Reconsideration of the application is requested in view of the following remarks.

Double Patenting Rejection

Claims 1 - 8 and 15 - 20 were rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 6,906,416. The Examiner stated:

Although the claims are not identical, they are not patentably distinct from each other because instant application and the patent both recite an inverted second package (i.e. upper package) stacked on a first package (i.e. lower package).

This is not well understood. The Examiner has not articulated how Applicant's invention as claimed would have been obvious over claim 1 of the reference patent (U.S. 6,906,416). It is not enough to state, as the Examiner has here, what may be recited in both the application claims and the patent claim. An obviousness analysis must follow, identifying the differences between the claims of the application and the claims of the reference patent, and stating reasons why those differences would have been obvious to the person of ordinary skill in the art. Because no obviousness analysis has been made here, Applicant cannot agree with the Examiner's double patenting rejection of the claims of the Application over claim 1 of the reference patent.

Applicant submits herewith a Terminal Disclaimer and a deposit account authorization to pay the fee therefor, and accordingly this Double Patenting rejection should be withdrawn.

Provisional Double Patenting rejections

Where no patent has yet issued and no claim has yet been allowed in a reference application, there would appear to be no predicate upon which Applicant can make a reasonable response to a Provisional Double Patenting Rejection. For example, Applicant cannot reasonably make a Terminal Disclaimer with respect to a reference application from which it is not yet known whether any patent will be granted. And, for example, when prosecution of the claims is not yet complete in a reference application, it is not possible to know whether the claims in the instant application claim the same invention as (for a statutory type double patenting rejection), or are patentably distinct from, claims in any patent that may issue from the reference application and,

Atty. Docket No. CPAC 1029-8
Appl. No. 10/681,734

PATENT

accordingly, Applicant cannot yet know whether, or how, any claim amendment should be made in the instant application.

In such circumstances, the Applicant may traverse the rejection on the grounds that it is not at this time possible to know what claims may eventually issue in the reference application and, accordingly, it is not possible to know whether the claims in the instant application will be patentably distinct, with or without amendment, from claims in any patent that may be granted on the reference application. Applicant responds accordingly, below.

Provisional Double Patenting Rejections under 35 U.S.C. §101

Claims 1 - 8 and 15 - 20 were provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claim 1 of copending Application No. 10/681,735.

Provisional Nonstatutory Double Patenting Rejections

Claims 1 - 8 and 15 - 20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting: over claim 1 of copending Application No. 10/681,572; or over claim 1 of copending Application No. 10/681,584 (the "Reference Applications"). (All these applications were filed on the same date, and are commonly owned.)

To the extent a reply may be required at this point in prosecution, these rejections are traversed, on the grounds following.

As the prior Office action noted, these are provisional double patenting rejections because the claims that are alleged to be conflicting have not in fact been patented. Moreover, prosecution of the claims is not yet complete in any of the Reference Applications: Claim 1 in each of Application No. 10/681,735 and in Application No. 10/681,572 stands rejected under 35 U.S.C. § 103 and/or § 102, and it is unknown to Applicant at this time whether (or to what extent) Applicants' responses to these rejections may be successful. Thus, it is not at this time possible to know what claims may eventually issue in any of the Reference Applications and, accordingly, it is not possible to know whether the claims in the instant application will claim the same invention, or will be patentably distinct, with or without amendment, from claims in any patent that may be granted on any of the Reference Applications.

Atty. Docket No. CPAC 1029-8
Appl. No. 10/681,734

PATENT

As the MPEP notes,

Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications ..., the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

(MPEP 804.I.B.) Applicant appreciates the Examiner's attention in having made the Applicant aware of what appeared to the Examiner to be a potential double patenting problem in the instant application. In the instant application, however, for the reasons noted above, it is not possible for the Applicant to resolve the issue at this time. Applicant expects that the provisional double patenting rejections will be maintained as long as there are conflicting claims in more than one application, until prosecution has proceeded to the point that the double patenting rejection is the only rejection remaining in one of the applications.

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications.

(MPEP 804.I.B.) Then:

If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

(MPEP 804.I.B.) This orderly process will allow the Applicant at an appropriate time to determine an appropriate response (traversal; or claim amendment; or, for the obviousness-type double patenting rejections, terminal disclaimer) to any double patenting rejection (fully matured, not "provisional") that may have been maintained in an application following issuance of a patent in another application that is alleged to have conflicting claims.

(Moreover, the Statutory Double Patenting rejection is improper because the claims in this Application are not coextensive in scope with claim 1 of U.S. Application No. 10/681,735.

(Indeed, the claims of the Application are not all coextensive in scope, and so they cannot all be coextensive in scope with claim 1 of U.S. Application No. 10/681,735.) Particularly, all the claims in this Application depend from claim 1, which recites "wherein the inverted upper package

Atty. Docket No. CPAC 1029-8
Appl. No. 10/681,734

PATENT

comprises a bump chip carrier package” and, accordingly, all the claims in this Application include a recitation “wherein the inverted upper package comprises a bump chip carrier package”. Claim 1 of Application No. 10/681,735 does not have such a recitation and, accordingly, none of the claims of this Application claims the **same invention** as claim 1 of Application No. 10/681,735.)

In this Application, a Terminal Disclaimer has disposed of the Obviousness-Type Double Patenting rejection over U.S. 6,906,416, and the provisional double patenting rejections are now the only rejections remaining in this Application. In these circumstances, the Examiner should withdraw the rejections in this Application and permit this Application to issue as a patent, thereby converting the “provisional” double patenting rejections in the Reference Application(s) into a double patenting rejection(s) once this Application issues as a patent. As the Examiner may appreciate, an early allowance of this Application should afford the Applicant sufficient information to enable the Applicant to act on the pending provisional double patenting rejections, by way of argument or amendment or Terminal Disclaimer, in the Reference Applications.

In view of the foregoing, all the claims now in the application, namely claims 1 - 8 and 15 - 20, are believed to be in condition for allowance, and action to that effect is respectfully requested

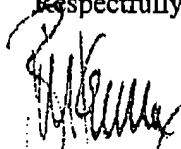
This Response is being filed, together with a Terminal Disclaimer and a fee therefor, within the three months’ shortened statutory period set by the Examiner for response to the Office action and, accordingly, no extension of time or extension fee is required. In the event the Examiner may determine that an extension of time and/or additional fee[s] may be required in connection with the filing of this paper, petition is hereby made therefor, and the Commissioner is authorized to charge any additional fee (or to credit any overpayment) to Deposit Account No. 50-0869 (CPAC 1029-8).

Atty. Docket No. CPAC 1029-8
Appl. No. 10/681,734

PATENT

If the Examiner determines that a conference would facilitate prosecution of this application, the Examiner is invited to telephone Applicants' representative, undersigned, at the telephone number set out below.

Respectfully submitted,

 *Reg. No. 33,407*
Bill Kennedy
Reg. No. 33,407

Haynes Beffel & Wolfeld LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340
BK:pfh